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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,779	11/04/2003	Kenji Inoue	P03344-US DIV	5901
21254	7590	08/23/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			SUMMONS, BARBARA	
			ART UNIT	PAPER NUMBER
			2817	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/699,779

Applicant(s)

INOUE, KENJI

Examiner

Barbara Summons

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/11/05 (amdt/submission) & 8/5/05 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-20 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-20, 27-30, 34 and 35 is/are allowed.
- 6) ☒ Claim(s) 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/4/03 & 1/13/05 (repl. sheets) is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/253,988.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/11/05 has been entered.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

On page 1, the first sentence of the specification (continuity data) inserted by the preliminary amendment, needs to be updated to include - - , now abandoned - - after "September 25, 2002".

Appropriate correction is required.

### ***Withdrawn Claim Rejections - 35 USC § 102***

3. Applicant's amendment and arguments received 7/11/05 have overcome the rejections of independent claims 5 and 8 and the claims that depend therefrom. Therefore, these rejections have been withdrawn.

### ***Maintained Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 31-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ehara et al. U.S. 5,905,418 (of record) for reasons of record substantially repeated below.

Fig. 1 of Ehara discloses a surface acoustic wave (SAW) branching filter with two SAW filter elements (Rx and Tx) that have different center frequencies corresponding to the receive and transmit frequencies of the device, wherein at least one of the two SAW filter elements as shown in Fig 25, comprises: a first wiring portion (a.k.a. series arm) between terminals IN and OUT; a plurality of second wiring portions (a.k.a. parallel arms) between the series arm and a reference potential terminal E; at least two single unit elements each comprising a first/series SAW resonator 114/118 having a second /parallel SAW resonator 120/124 at an input side thereof and a third/parallel SAW resonator 122/126 at an output side thereof, and each unit element having the reference potential sides of the second and third parallel SAW resonators connected to each other at a connection point/node and a corresponding inductance element 128/130 (see col. 10, line 6) located between the connection point and the reference potential terminal E. Additionally, regarding the resonator resonant and anti-resonant frequencies, Ehara is modifying the prior art ladder filter of Fig. 8 such that the resonant frequency of the series resonators and the anti-resonant frequency of the parallel resonators must inherently substantially correspond to each other in order to form a usable band pass

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filter as evidenced by the other prior art of record and as also admitted by Applicant (see Applicant's specification at page 14, lines 13-20).

Regarding claim 31, the resonant frequency of the two single unit elements correspond with each other since they are both designed as section 106 in Fig. 23 (see col. 10, lines 7-10). Regarding claim 32, Fig. 25 of Ehara also shows a fourth resonator 116 between two first/series resonators 114 and 118, and resonator 112 can also be considered a fourth resonator between the first series resonator 114 and the input terminal. Regarding claim 33, since the equivalent circuit of the fourth SAW resonators 112 and 116 is an LC resonator circuit and because SAW resonators have both electrostatic and motional capacitance values, these resonators can also be considered "capacitance elements" by the broadest interpretation of the term.

#### ***Allowable Subject Matter***

6. Claims 5-20, 27-30, 34 and 35 are allowable over the prior art of record.

#### ***Response to Arguments***

7. Applicant's arguments filed 7/11/05 have been fully considered but they are not persuasive regarding claims 31-33.

Applicant argues persuasively regarding the amended subject matter of previously rejected independent claims 5 and 8, and these rejections have been withdrawn. That is, the specific connections of the capacitance between the recited nodes in claim 5, and the recited specific attenuation poles in claim 8, are not shown by the prior art of record.

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However, there do not appear to be any arguments specifically addressing claims 31-33 which were previously rejected and have not been amended. Therefore, no further response by the Examiner is considered necessary at this time, and the rejection of claims 31-33 is maintained.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Summons whose telephone number is (571) 272-1771. The examiner can normally be reached on M-Th, M-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pascal can be reached on (571) 271-1769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bs  
August 21, 2005



**BARBARA SUMMONS**  
**PRIMARY EXAMINER**